



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/796,226 | 03/09/2004 | Michael Collins | PC19103B | 4162 |

28940 7590 01/11/2005

AGOURON PHARMACEUTICALS, INC.
10350 NORTH TORREY PINES ROAD
LA JOLLA, CA 92037

| |
|----------|
| EXAMINER |
|----------|

AULAKH, CHARANJIT

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1625

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,226

Applicant(s)

COLLINS ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-78 is/are allowed.
- 6) ☒ Claim(s) 52-75 and 79-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. According to paper filed on Nov. 8, 2004, the applicants have amended claims 52, 72 and 76.
2. Claims 52-103 are pending in the application.

Response to Arguments

3. Applicant's arguments filed on Nov. 8, 2004 have been fully considered but they are not persuasive regarding enablement, indefiniteness and obviousness rejections. In regard to enablement rejection, the examiner does not agree with the applicants arguments that the specification is enabling for treating every known proliferative disease, every known kidney disease, all known diseases related to angiogenesis, pancreatitis and blastocyte implantation. The applicants have not provided any prior art references showing utility of VEGF or FGF inhibitors in treating every known proliferative disease, every known kidney disease, all known diseases related to angiogenesis, pancreatitis and blastocyte implantation. There are no working examples present showing efficacy of instant compounds in known animal models of every known proliferative disease, every known kidney disease, all known diseases related to angiogenesis, pancreatitis and blastocyte implantation.

In regard to indefiniteness rejections, the examiner does not agree with the applicants arguments that these terms are defined in the specification and therefore, there is no need to include specific diseases in the claim. It is the claim language which is important and the claim language needs to be definite.

Art Unit: 1625

In regard to obviousness rejections, the examiner does not agree with the applicants arguments that it would not have been obvious to one skilled in the art to prepare the instant compounds. It is true that there is no exemplified compound present in these two cited references where indole ring is substituted with –CON group. However, the compounds of both of these two cited references have same utility as the instant compounds and furthermore, teach that indole ring may be substituted with R5 group. Therefore, R5 substitution is not critical for the intended utility as taught by both of these references. Therefore, it would have been obvious to one skilled in the art to prepare numerous other compounds with R5 substituents without affecting the intended utility unless applicants provide evidence of unexpected results such as superior activity of the instant compounds compared to prior art compounds with unsubstituted indole ring. The examiner also does not agree with the applicants arguments that Marx's reference (WO 03/000194) is not a prior art reference. This international application was filed on June 20, 2002 (after Nov. 29, 2000), is published in english and designates US as one of the states and has priority date of June 21, 2001 and therefore, is available as a prior art reference.

Conclusion

4. All rejections under 35 U.S.C. 112, first paragraph and second paragraph as well as under 35 U.S.C. 103(a) are maintained for the reasons of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
Art Unit 1625